

Remarks/Arguments:

Claims 1-5, 6 and 7-21 were rejected as being unpatentable over the Applicant's admitted prior art in view of various combinations of Svala (US Patent 4348768), La Marche et al (US Patent 3673355) and Seidel et al (US Patent 4048453). Because the Applicant did not admit prior art nearly to the extent relied upon by the Examiner and because the Examiner has impermissibly combined references for which there is no suggestion or motivation to so combine and because the Examiner has impermissibly utilized the teachings of the present application to piece together a combination of references for which there is no teaching suggesting such combinations, along with "inferred" technology elements, the Applicant traverses the rejection and requests reconsideration and allowance of the pending claims.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references must teach or suggest all the claim limitations. The teaching or

suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on applicant's disclosure. MPEP 2143, p. 2100-121 (August 2001).

With respect to the alleged admissions in the specification, the applicant notes that the cited specification with the alleged admission states:

The present trend is to replace traditional Time Division Multiplexed (TDM)-based telephone networks with packet switched, Internet Protocol (IP) networks such as Corporate local area networks (LANs), wide area networks (WANs), and the Internet. While IP networks offer many advantages over TDM networks, the IP networks experience their own problems.

The Applicant first observes that the section in which this discussion appears is entitled "Description of the Related Art". An admission that the art is "related" does not necessarily render it an admission of prior art. In many cases, the description may well be of technologies presently under development that have their own problems or shortcomings. As voice over IP was a new technology area at the time of invention and filing of the present application, the Applicant has not and does not admit that the cited discussion is prior art, only that it is related art.

Moreover, the text only admits that there is a present trend to replace traditional TDM based telephone networks with the packet switched IP networks. While the statement is true, the fact remains that the telephone network has always been and still is the world's largest computer network in addition to being a voice network, and is used extensively for transporting data for peer to peer connections, facsimile transmissions, etc. Thus, this statement about the Internet replacing the telephone network is not clearly directed to voice and does not clearly state that the data packet IP network is replacing the telephone networks for voice. It merely states that there is a trend to replace the telephone networks with IP networks.

This point is important because the Examiner proceeds to explain that the admission by the Applicant “inherently comprises a telephone unit with a microphone and speaker...a computer for the purpose of interfacing with the IP network...a processor (controller) coupled to the bus interface... and converter for the purpose of synchronizing and commanding the signaling between the converter and the interface.” The Applicant strenuously objects and disagrees that the cited passage is an admission of each of these elements.

Claim 1 requires:

An apparatus for control of echo return loss in a communication system using a packet switched network, the communication system comprising a telephone device having a plurality of transducers and a computer for running a communication process, the apparatus comprising:

a converter coupled to the telephone device, the converter generating analog signals from digital signals and digital signals from analog signals;

a bus interface coupled to the computer, the bus interface coupling the apparatus to the communication system; and

a controller coupled to the converter and the bus interface, the controller controlling operation of the apparatus by detecting and attenuating echo conditions.

As may be seen, the Examiner has substantially listed the elements of the claim and found that the cited passage from the application “inherently” admits these elements (as prior art). Besides the point made above that the cited passage does not admit nearly as much as it is giving credit for admitting, it is clearly impermissible to attribute elements not taught in a particular passage by inference with the help of the claim language.

Thus, as each rejection substantially relies upon admissions of prior art that clearly were not made as shown herein this response, the rejections fail for this reason alone. Additionally, even if the Applicant admitted IP telephony was prior art, the specific elements which the Examiner listed as being “inherent” certainly were not admitted. The view that success would have been “inherent” cannot substitute for a showing of reasonable expectation of success. *In re*

Reinhart, 531 F.2d 1048, 189 U.S.P.Q. 143, 148 (C.C.P.A. 1976), “That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” A retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. *In re Rijckaert*, 9 F.3d 1531, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

Moreover, the rejections also fail because there is no teaching to combine the references as they have been combined with each other and with the cited passage from the present application. Svala teaches a PCM CODEC using common D/A converter for encoding and decoding. Specifically, the PCM CODEC of Svala is particularly for producing PCM output data on a PCM bus based upon received analog signals. Svala does not teach using a CODEC to produce data to a computer for transmission over a data packet network. La Marche et al., on the other hand, teaches circuitry for accomplishing digital echo suppression for a plurality of two-way transmission circuits (e.g., in a PCM telephone network). La Marche et al. do not teach using echo suppression in conjunction with a head set (speaker and microphone) and a computer terminal that will NOT be transmitting voice over a PCM telephone network but, rather over a data packet IP network. Finally, Seidel teaches a telephone handset support device which, as shown in Figure 12, facilitates coupling a traditional telephone handset to the support device to enable hands free operation.

None of these references is in an art area related to the other references and there is no suggestion in any of these references to examine the art areas of the other references to combine such references. The required teaching to combine these references does not exist and, therefore, their combination to form the rejection is impermissible. A basic mandate inherent in 35 USC §103 is that a “piecemeal” reconstruction of prior art patents in light of <an applicant’s> disclosure shall not be a basis for a holding of obviousness. *In re Kamm and Young*, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972).

Additionally, even if combined, these references do not teach what is required by claim 1 as indicated above. Specifically, these references even in combination do not teach a converter in combination with a bus interface coupled to a computer in combination with a controller for

detecting and attenuating echo conditions. With respect to claim 2, such combination is not taught in relation to a USB interface.

In conclusion, there is not suggestion that has been shown either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, no reasonable expectation of success has been shown for such a combination. Finally, the references do not teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on applicant's disclosure. As such, the Applicant respectfully traverses this rejection in that a *prima facie* case of obviousness has not been established. Finally, because all of the rejections rely on "inherent" elements of a system which is not admitted prior art, the rejections cannot stand because (1) they are not admitted and (2) they are not actually taught or suggested and cannot be included through "inherency".

For each of the remaining grounds of rejections that are made in addition to those discussed above that apply to all independent claims, the official action further makes "obvious to try" type rejections (though these words are not necessarily used) that are impermissible and are denied for the Applicant. For example, with respect to claims 1, 2, and 15, the Examiner stated it would be obvious to combine wave signaling with a USB port, to convert a CODEC output to WAVE to render compatibility between the headset and the computer. As another example, the Examiner relies on the present application teachings to find the method of claim 8 obvious without citing a teaching of the same in the prior art. The prior art does not teach such echo cancellation in a computer-based communication device. The Examiner is required to provide a teaching or suggestion for such combinations. As such, the rejection is traversed.

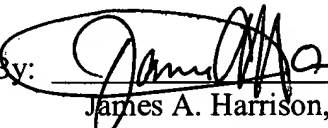
As the Examiner found that the grounds of rejection for claim 1 also applied to each of the pending independent claims, the Applicant notes that the above arguments apply with equal force to all of the rejections for all of the pending claims. As such, to avoid urging duplicative arguments, the Applicant will not repeat the response for the remaining claims.

The Applicant specifically traverses and objects to all allegations of admission except as otherwise indicated herein and further objects to each allegation of inherency and of each combination of elements made from the differing references with an express teaching or suggestion to so combine. Further, the Applicant objects to the cited art in that they are impermissibly being combined from unrelated art areas without a teaching or suggestion to so combine.

Please direct any questions or comments to the undersigned attorney regarding the Notice of Allowance in this case.

Respectfully submitted,

Date: November 5, 2004

By: 
James A. Harrison, Reg. 40,401
Garlick Harrison & Markison, LLP
P.O. Box 670007
Dallas, Texas 75367
(214) 902-8100/office
(214) 902-8101/facsimile